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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.             | CONFIRMATION NO.            |
|---|-------------|----------------------|---------------------------------|-----------------------------|
| 10/525,246  | 04/06/2006  | Kouichirou Taniguchi | 266004US0XPCT                   | 5377                        |
| 22850 7590 01/26/2009<br>OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | EXAMINER<br>KRUER, KEVIN R      |                             |
|   |             |                      | ART UNIT<br>1794                | PAPER NUMBER                |
|   |             |                      | NOTIFICATION DATE<br>01/26/2009 | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/525,246 | <b>Applicant(s)</b><br>TANIGUCHI ET AL. |  |
|                              | <b>Examiner</b><br>KEVIN R. KRUER    | <b>Art Unit</b><br>1794                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marotta et al (US 5,888,640) in view of WO/2001096490-Kijima et al (herein US 2004/0039117 is relied upon as an English translation thereof).

Marotta teaches a laminated film for heat shrinking comprising a core and skin layers on both sides of said core (col 7, lines 16+). The core layer comprises an isotactic polypropylene copolymer comprising 2-7wt% ethylene and having a melting point of 125-150C (col 4, lines 22+). Said polymer is herein relied upon to read on claimed component (C). The core further comprises an atactic modifier in amounts of 10-99wt% (col 3, lines 52+). The skin layers comprise any biaxially orientable heat shrinkable film forming resin known in the prior art (col 6, lines 35+) such as ethylene polymers such as LLDPE, LDPE, or HDPE.

With regards to the limitation "for stretch wrapping" the examiner notes said limitation is a preamble intended use limitation that does not distinguish the claimed film from the prior art. Specifically, the prior art film is understood to be usable as a stretch wrap film since it comprises the same layers and the same compositions as the claimed film.

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Marotta teaches the modifier may comprise 1-99wt% of the core but does not teach the core's modifier should comprise claimed components (B) and (D) in the claimed amounts. However, Kijima teaches an atactic polypropylene composition comprising 20-99mass% of a propylene based polymer satisfying the limitations of component (B) (abstract) and 80 to 1 mass% of an adhesive capacity applying resin comprising terpene or petroleum resin (0045) and hydrogenated derivatives thereof. It is noted that the commercial petroleum listed in Kijima (0045) meet the claimed softening point limitations of claim 5. Said composition is atactic and has superior adhesive properties. Thus, it would have been obvious to utilize the blend taught in Kijima as the atactic polypropylene taught in Marotta because said blend is atactic and would improve the adhesion between the core layer and the skin layers.

It is noted that the resulting core composition comprising 1-99wt% isotactic polypropylene and 99-1wt% of a 20:80-99:1 blend of components (B) and (D) is herein understood to render obvious the claimed compositions comprising the claimed amounts of (B), (C), and (D) since the ranges rendered obvious by the prior art are encompass the claimed ranges.

With regards to claim 6, said properties are herein understood to be latent properties of the film rendered obvious by the prior art since the prior art film comprises the same layers having the same compositions as the claimed film.

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marotta et al (US 5,888,640) in view of WO/2001096490-Kijima et al (herein US 2004/0039117 is

relied upon as an English translation thereof), as applied to claims above, and further in view of Bieler (US 4,127,688) or Warren (US 4,853,265).

Marotta in view of Kijima is relied upon as above, but does not teach the skin layer should comprise the claimed EVA. However, Bieler teaches that EVA copolymer having from 2-30wt% EVA is a known heat shrinkable olefinic composition. Marotta teaches said layer should have a melt flow of 5-10 (col 6, lines 53+). Furthermore, Warren teaches EVA as a skin layer for a heat shrinkable film. The EVA meets the claimed vinyl acetate content and melt flow rates (see examples). Thus, it would have been obvious to utilize the claimed EVA film as the skin layer taught in Marotta because said films are known in the art to be excellent heat shrinkable skin layers.

### ***Response to Arguments***

Applicant's arguments filed 10/10/2008 have been fully considered but they are not persuasive.

Applicant argues neither Marotta nor Kijima discloses or suggests a laminated film for stretch wrapping comprising the laminate of claim 1 or the intermediate layer composed of resin composition containing the component B, C, and D. The examiner agrees but notes that neither Kijima nor Marotta was ever relied upon to anticipate the claimed invention. Rather, claim 1 was held to be obvious over Marotta in view of Kijima. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

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USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant further argues the meso-pentad fraction of the invention is critical to the invention. Specifically, when it was too high, flexibility was reduced and when it was too low, crystallinity was excessively lowered. Applicant points to no data to support said conclusion. Furthermore, said results are expected by the skilled artisan; the skilled artisan would have known the meso-pentad functionality was proportional to crystallinity and that highly crystalline materials are not flexible.

With regards to the ratio of racemic pentad fraction and its effect on processability, applicant has again failed to point to any data support a criticality argument. Applicant also argues the amounts of components B, C, and D in the core layer is critical but has failed to point to any data supporting said conclusion. Applicant is reminded that counsel's argument cannot take the place of evidence. Furthermore, Applicant has the burden of establishing/explaining any showing of criticality.

Applicant argues the limitation "for stretch wrapping" is not a preamble intended use limitation but an essential limitation to attain the present invention. Said argument is noted but is not persuasive. Specifically, applicant has failed to explain what structural differences are inherent to the preamble limitation and how said differences distinguish the claimed invention from the prior art.

With regards to claim 6, applicant argues said claim defines properties of the laminate film which are critical to the claimed invention. Specifically, when the storage modulus is too low, the film has excessive flexibility and when it is too high, the film has

excessive hardness. Said argument is noted but is not persuasive because the skilled artisan would have known to select a storage modulus in order to control hardness and flexibility.

With regards to the other properties of claim 6, Applicant is reminded that counsel's argument cannot take the place of evidence. Furthermore, Applicant has the burden of establishing/explaining any showing of criticality. No such evidence has been cited by applicant.

With regards to claim 3, applicant argues said claim fails to correct the deficiencies of Marotta and Kijima with respect to claim 1. Said argument is not persuasive for the reasons stated above.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN R. KRUER whose telephone number is (571)272-1510. The examiner can normally be reached on Monday-Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin R Krue/

Primary Examiner, Art Unit 1794



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| <div><b>Application Number</b></div> <div></div> | <b>Application/Control No.</b> | <b>Applicant(s)/Patent under Reexamination</b> |  |
|   | 10/525,246                     | TANIGUCHI ET AL.                               |  |
|   | <b>Examiner</b>                | <b>Art Unit</b>                                |  |
|   | KEVIN R. KRUER                 | 1794   |  |